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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/759,232  | 01/16/2001  | Takchiro Yoshida     | 862.C2092           | 9935             |
| 5514  | 7590        | 07/02/2004           | EXAMINER            |                  |
| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      | CARTER, TIA A       |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 2626                 | 2                   |                  |
| DATE MAILED: 07/02/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                   |
|------------------------------|-----------------|-------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)      |
|                              | 09/759,232      | YOSHIDA, TAKEHIRO |
| Examiner                     | Art Unit        |                   |
| Tia A Carter                 | 2626            |                   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-8 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Otsuka et al. (US. 6657743).

Regarding claim 1, Otsuka discloses a communication method for selectively performing facsimile communication via the Internet and facsimile communication without the Internet (fig. 9, col. 10, lines 4-8),

Wherein a communication parameter is changed based on whether the facsimile communication via the Internet or the facsimile communication without the Internet is to be performed (figs. 9, col. 10, lines 8-22).

Regarding claim 4, Otsuka et al. discloses the communication method according to claim 1, further comprising a detection step of detecting whether the facsimile

communication via the internet or the facsimile communication without the internet is to be performed (Fig. 10, col. 10, lines 43-64).

Regarding claim 5, Otsuka et al. discloses the communication method according to claim 1, further comprising a determination step of determining whether the facsimile communication via the internet or the facsimile communication without the internet is to be performed, based on the information inputted by a user (fig. 10, col. 10, lines 43-46).

Regarding claim 6, Otsuka et al. disclose the communication method according to claim 5, wherein at said determination step, upon call origination, determines whether the facsimile communication via the Internet or the facsimile communication without the internet is to be performed, based on a call destination (fig. 10, col. 10, lines 31-64).

Regarding claim 7, Otsuka et al. discloses the communication method according to claim 5, wherein at said determination step, upon reception of incoming call, determines whether the facsimile communication via the Internet or the facsimile communication without the internet is to be performed, based on originator telephone number information (fig. 9, col. 9, lines 42-44; col. 10, lines 5-21).

Regarding claim 8, Otsuka et al. discloses a communication apparatus capable of facsimile communication via the Internet (fig. 1, col. 7, lines 2-12), comprising:

Changing means for changing a communication parameter is changed based on whether the facsimile communication via the Internet or the facsimile communication without the Internet is to be performed (fig. 9, col. 10, lines 4-8).

Regarding claim 11, Otsuka et al. discloses the communication apparatus according to claim 8, further comprising a detection step of detecting whether the facsimile communication via the internet or the facsimile communication without the internet is to be performed (Fig. 10, col. 10, lines 43-64).

Regarding claim 12, Otsuka et al. discloses the communication apparatus according to claim 8, further comprising a determination step of determining whether the facsimile communication via the internet or the facsimile communication without the internet is to be performed, based on the information inputted by a user (fig. 10, col. 10, lines 43-46).

Regarding claim 13, Otsuka et al. disclose the communication apparatus according to claim 12, wherein at said determination step, upon call origination, determines whether the facsimile communication via the internet or the facsimile communication without the internet is to be performed, based on a call destination (fig. 10, col. 10, lines 31-64).

Regarding claim 14, Otsuka et al. discloses the communication apparatus according to claim 12, wherein at said determination step, upon reception of incoming call,

determines whether the facsimile communication via the internet or the facsimile communication without the Internet is to be performed, based on originator telephone number information (fig. 9, col. 9, lines 42-44; col. 10, lines 5-21).

Regarding claim 15, Otsuka et al. discloses a computer-readable memory holding a communication program (fig. 3, col. 7, lines 26-32) for selectively performing facsimile communication via the Internet and facsimile communication without the Internet (fig. 9, col. 10, lines 4-8),

Said communication program includes a program to change a communication parameter based on whether the facsimile communication via the Internet or the facsimile communication without the Internet is to be performed (figs. 9, col. 10, lines 8-22).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. (US. 6657743) in view of Iijima (US. 5748915)

Regarding claim 2, Otsuka et al. discloses the communication method according to claim 1.

Otsuka et al. **do not disclose** wherein said parameter is a transmission speed for the communication.

Iijima **disclose** wherein said parameter is a transmission speed for the communication (fig. 4, col. 7, lines 14-21)

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka et al. wherein upon determining the communication link that the transmission rate is part of the transmitting/receiving selection whereas data sent/received via internet transmits at a different rate than that of PSTN this additional feature would prevent transmission/reception delay.

Regarding claim 9, Otsuka et al. discloses the communication apparatus according to claim 8.

Otsuka et al. **do not disclose** wherein said parameter is a transmission speed for the communication.

Iijima **disclose** wherein said parameter is a transmission speed for the communication (fig. 4, col. 7, lines 14-21)

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka et al. wherein upon determining the communication link that the transmission rate is part of the transmitting/receiving selection whereas data

sent/received via internet transmits at a different rate than that of PSTN this additional feature would prevent transmission/reception delay.

5. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. (US. 6657743) in view of Endo (US. 6522429)

Regarding claim 3, Otsuka et al. disclose the communication method according to claim 1.

Otsuka et al. **do not discloses** wherein said parameter is allowable delay time.

Endo **discloses** wherein said parameter is allowable delay time (fig. 4, col. 9, lines 30-34; fig. 1, col. 13, lines 18-40).

It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka et al. wherein upon determining the communication link, a timer would be implemented to prevent retransmission of data preventing transmission/reception backup.

Regarding claim 10, Otsuka et al. disclose the communication apparatus according to claim 9.

Otsuka et al. **do not discloses** wherein said parameter is allowable delay time.

Endo **discloses** wherein said parameter is allowable delay time (fig. 4, col. 9, lines 30-34; fig. 1, col. 13, lines 18-40).

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It would have been obvious to one skilled in the art at the time of the invention to modify Otsuka et al. wherein upon determining the communication link, a timer would be implemented to prevent retransmission of data preventing transmission/reception backup.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Amit et al. (US. 6259538), Otsuka (US. 6424425), Schuster et al. (US. 6483600), and Idehara (US. 6438605) are cited to show related art with respect to facsimile transmission/reception via Internet or PSTN.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tia A Carter whose telephone number is 703 - 306-5433. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tia A Carter  
Examiner  
Art Unit 2626



TAC  
June 22, 2004



MADELEINE NGUYEN  
PATENT EXAMINER